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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,663	11/29/2001	Lorraine Faxon Meisner	121753-1004	5796

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EXAMINER

CHOI, FRANK I

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 12/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/997,663

Applicant(s)

MEISNER, LORRAINE FAXON

Examiner

Frank I Choi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/19/2002, 9/13/2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Examiner notes that the rejections herein are not intended to and do not apply to the claimed subject matter which was found to be allowable in US 6,444,699 and US 6,217,914.

Terminal Disclaimer

The terminal disclaimer filed on 9/16/2002 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any Patent issued from Application No. 09/990,611 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schinitsky et al. (US Pat. 4,938,969) in view of Murad (US Pat. 5,804, 594), Herstein (US Pat. 5,902,591) and Taylor et al. (US Pat. 5,308,621)

Schinitsky et al. teach a composition and method to reduce epidermal wrinkling resulting from photo-aging comprising ascorbic acid (about 2-20%), tyrosine (about 1-10%) and zinc sulfate (about 0.5-5%) in a pharmaceutically acceptable vehicle, for example, hydrophilic lotion, ointment, cream or gel, which is applied once or twice daily (Column 2, lines 38-53, Column 4, lines 34-45, Claims 1, 2).

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Murad teaches a composition for treatment of skin overexposed to sunlight and wrinkles comprising a sugar, such as N-acetylglucoseamine or glucoseamine, amino acids, such as cysteine, methionine or N-acetyl cysteine, ascorbic acid, and a zinc compound, such as zinc sulfate (Column 4, lines 62-68, Columns 5, 6, Column 7, lines 30-41, Column 9, lines 3-7). It is taught that the composition may be formulated as a cream, paste, gel, ointment, solution or suspension in an aqueous liquid, oil-in-water emulsion or a water-in-oil emulsion by any methods of pharmacy which can be applied topically (Column 8, lines 43-49, Column 9, lines 34-45). It is taught that the sugar and amino acids assist in thickening the dermis and supplementing collagen and elastic tissues which reduces wrinkling and lines (Column 5, lines 5-18). It is taught that the addition of ascorbic acid inhibits collagenase and elastase, enzymes which break down collagen and elastic tissues, and assist in the reducing the occurrence of additional wrinkles and facilitate the healing of skin tissues (Column 5, lines 18-22). It is taught that zinc binds collagen fibers and inhibits elastase, an enzyme that also breaks down collagen and elastic tissue (Column 5, lines 22-24).

Herstein teaches that a pH within 3.5 to 4.1 is preferred to facilitate entry of ascorbic acid into the skin and stabilize the ascorbic acid molecule (Column 2, lines 40-47, Column 10, lines 6-17).

Taylor et al. teaches a method of preparing ascorbic acid by heating to dissolve the ascorbic acid and optionally cooling which ascorbic acid is used in topical preparations containing polyhydric alcohols (Column 2, lines 20-26, Column, 3, lines 17-65).

The difference between the prior art and the claimed invention is that the prior art does not expressly disclose a topical composition comprising at least about 5.0% (w/v) pretreated

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ascorbic acid, water. Applicant has argued that by "pretreatment" it is meant the definition contained within the Specification (Pg. 7). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the process by which the "pretreated" ascorbic acid is prepared) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 26 USPQ2d 1057 (Fed. Cir. 1993). See also *In re Morris*, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (The court held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit). In any case, the prior art does teach heating the ascorbic acid to dissolve the same and, optionally cooling, as is disclosed in the Specification under the definition of "pretreatment". As such, it would have been well within the skill of and one of ordinary skill in the art would have been motivated to modify the prior art as above with the expectation that the combination of said components would effectively treat and reduce wrinkles and increase the stability of the ascorbic acid present within the composition.

Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of the references.

Conclusion

A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machines are (703) 308-4556 or (703) 305-3592.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Choi whose telephone number is (703) 308-0067. Examiner maintains a flexible schedule. However, Examiner may generally be reached Monday-

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Friday, 8:00 am – 5:30 pm (EST), except the first Friday of the each biweek which is Examiner's normally scheduled day off.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. José Dees, can be reached on (703) 308-4628. Additionally, Technology Center 1600's Receptionist and Customer Service can be reached at (703) 308-1235 and (703) 308-0198, respectively.

FIC

December 2, 2002



JOHN PAK
PRIMARY EXAMINER
GROUP 1600

